

Appl. No. 10/021,633
Amdt. dated November 20, 2003
Reply to Office Action of June 2 2003

Remarks/Arguments

Claims 1, 2, 4-7, 2, 14, 15, 16, 19 and 20 were under consideration in this application. By this Amendment, claims 1, 4, 5, 6, 19 and 20 have been amended. Claim 7 has been canceled. Claims 3, 8-11, 13, 17, 18 and 21-44 have been previously withdrawn. The changes to the claims do not constitute the addition of new matter and full support for the changes may be found throughout the specification and claims as originally filed. Specifically, support for the amendment to claim 6 may be found *inter alia* at page 13, line 13 of the specification. Accordingly, claims 1, 2, 4-6, 12, 14-16, and 19-20 remain under consideration in this application.

Claim Rejections -35 U.S.C. §102

On page 3 of the June 2, 2003 Office Action, the Examiner rejected claims 1, 4, 6, 7, 19 and 20 Under 35 U.S.C. § 102(a); (b); (e) and /or (f) as allegedly anticipated by: Daines (WO 98/09630), Wagner et al. (US 5,453,432), Deyanov et al. (CA 115:279952), Kester et al., (US 4,855,308), Barchiesi et al., (CA 108:130898), Moerkved (CA 106:156246), Shramm et al. (CA 102:166694), Ferranti et al. (CA 102:149072), Abramovitch et al. I (J. Org. Chem. 1983, 48, 4391-4393), II (CA 92:14 559), III (J. Org. Chem., 1974, 39, 1795-1802), IV (CA 84:74053), V (J. Org. Chem., 1974, 39, 802-1807), VI (US 3,624,096) Peterson et al., (CA 95:169072), Shell (CA 95:97849) and Aries (Fr 7:599).

In response, claims 1, 19 and 20 have been amended and claim 7 has been canceled. Claims 4 and 6 depend from claim 1. Applicants respectfully submit that claims 1, 4, 6, 7, 19 and 20, as amended, are not anticipated by any of the aforementioned cited references. Accordingly, applicants request that the Examiner withdraw the rejection under 35 U.S.C. §102.

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Claim Rejections -35 U.S.C. §103

On page 5 of the June 1, 2003 Office Action, the Examiner rejected claims 1, 2, 4-7, 12, 14, 15, 16, 19 and 20 under 35 U.S.C. §103(a) as being allegedly unpatentable over the combined teachings of Daines Wagner et al., Deyanove et al., Kester et al., Barchiesi et al., Moerkved, Shramm et al. Feranti et al., Abramovitch et al., I-IV, Peterson et al., Shell and Aries.

In response, Applicant respectfully traverse. Applicants submit that the instantly pending claims, as amended, are not generically embraced by the disclosed formulae. However, even if they are, there is no motivation, thus it would not have been obvious to one skilled in the art, to make these particular compounds as defined by the instantly pending amended claims. None of the cited references, nor any combination thereof, motivate one skilled in the art to make these particular compounds as inhibitors of microsomal triglyceride transfer protein. The Examiner has cited inter alia In re Gyurik et al., 596 F.2d 1012, for the proposition that the motivation to make these compounds and thus the *prima facie* case of obviousness, arises out of "the expectation that compounds similar in structure will have similar properties." However, none of the cited references relate to inhibitors of microsomal transfer protein. Accordingly, none of the references motivate one skilled in the art to make the instant compounds, which are inhibitors of microsomal transfer protein and have utility for the treatment of inter alia atherosclerosis, obesity, hypercholesterolemia and hypertriglyceridemia. Accordingly, these claims are not rendered obvious by the cited references. Applicants respectfully request the Examiner to reconsider and withdraw the rejection under 35 U.S.C. §103.

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Claim Rejections -35 U.S.C. §112

On pages 7-8 of the June 2, 2003 Office Action, the Examiner rejected claims 1, 5, 6 and 7 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not discussed in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner Stated, "The expression "substituted" is employed in claims 1, 5, 6 and 7 with no indication given as to what the substituents and protective groups really are."

Applicants respectfully traverse this rejection to the extent the Examiner deems it applicable to the amended claims. Applicants submit that there is express indication given, in the instant specification, as to what the substituents are. Specifically, "substituted pyridyl" is defined at page 13, line 2, et seq. of the instant specification. Similarly, "substituted phenyl" is defined at page 14, line 4 et seq. of the instant specification. Further, the express recital of the term "substituted pyridyl" and "substituted phenyl" in the subject claims is all that is required to properly include the limitation, recited in the specification, into the subject claims. The cited In re Priest is not on point with regard to the facts. Applicants respectfully request that the Examiner reconsider and withdraw the rejection under 35 U.S.C. §112, first paragraph.

On page 9 of the June 2, 2003 Office Action, the Examiner rejected claims 19 and 20 under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response, Applicants have amended claims 19 and 20 to more particularly point out and distinctly claim Applicants' inventive subject matter. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. §112, second paragraph.

Priority

The status of the parent application, Serial No. 09/422,568 is abandoned.

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Conclusion

Applicants respectfully submit that they have properly accommodated, traversed or rendered moot each of the stated grounds of rejection in the June 2, 2003 Office Action. Accordingly, Applicants request that the Examiner withdraw those grounds of rejection and earnestly solicit allowance of the instant application.

If the Examiner has any questions or believes further discussion will aid examination and advance prosecution of this application, a telephone call to the undersigned is invited. If there are any additional fees due in connection with the filing of this amendment, please charge any such fees to Deposit Account No. 23-0455.

Respectfully submitted,

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